



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,185	12/15/2003	Nobuo Sugino	F-8064	4336
28107	7590	06/01/2005	EXAMINER	
JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			PURVIS, SUE A	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/736,185

Applicant(s)

SUGINO, NOBUO

Examiner

Sue A. Purvis

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,8,10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8,10 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The amendment filed 14 March 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The newly amended specification on page 5, lines 8-10 state "the surface tension such that it will spread...". This feature is also in newly amended claim 1 and discussed in the Remarks section of the response filed by the applicant, however, the examiner was unable to find where support for this comes from as it does not appear in the original specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's addition of "the surface tension allows it to spread" appears to be new matter as this was not discussed or disclosed in the original specification.

Art Unit: 1734

Additionally, the examiner could find no support in the specification for having an adhesive which is soluble both in water and alcohol.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Regarding claim 1, the phrase "allows it to spread" renders the claim indefinite because it is unclear whether the limitation is a positive step or just a possible step in the claim. Furthermore what is spreading exactly, the adhesive, the pattern, or the surface tension. Clarification is required.

7.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 2, 4, 5, 7, 8, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Brault et al. (US Patent No. 5,601,959).

Brault discloses a transfer method comprising the steps of (Figures 1-12; column 4, line 38 to column 9, line 63):

( 1) Providing a transfer sheet comprising a carrier 24 and transferable overcoating layer 26 (column 4, lines 20-35);

Art Unit: 1734

(2) Providing a pattern 18 onto the upper surface of the transfer sheet by electrophotographic printing (column 4, lines 38-62);

(3) Applying an adhesive 22 onto the image 18 disposed on the surface of the transfer sheet 24, 26 (column 5, line 41 to column 6, line 17);

(4) Contacting under the effects of pressure and/or heat, the adhesive coated transfer sheet 24, 26, 18, 22 with a target substrate 20 to bond and transfer the image 18 with the substrate 20 via the adhesive layer 22 (column 6, lines 27-63); and

(5) Stripping or peeling the carrier 24 of the transfer sheet 24, 26 from the image 18 adhesively bonded to the substrate 20 (column 6, lines 64-68).

Regarding applicant claims 1, 2, 7 and 10, Brault et al. disclose that the adhesive may comprise a pressure-sensitive, such as 3M Scotch Brand Spray Mount (a transparent adhesive), heat activatable adhesives such as those based on thermoplastic polyurethane, polycaprolactone and acrylic copolymers (column 5, lines 41 to column 6, line 26).

Regarding applicant claims 4, 6 and 8-12, Brault et al. disclose that the transfer sheet 24, 26 may utilize a release layer ("remover layer") 30 disposed over the carrier sheet by coating (column 8, lines 55-59).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Brault as applied to claim 1 above, and further in view of Sandor (US Patent No. 6,110,317).

Art Unit: 1734

Brault discloses a transfer method wherein the transfer sheet includes an intermediate layer 26 between the release layer 30 and the image layer 18 which, upon transfer, remains attached in an overlaying relationship to the image layer 18 adhered to the substrate 20 by adhesive layer 22. Brault further discloses that the intermediate layer 26 is transparent and protects the image 18 from abrasion, fading, chemical degradation or damage (column 9, lines 13-20).

Although they do not specifically disclose, as per applicant claim 3, that such a protective layer is applied over the transferred image after the transfer step has been carried out, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the protective layer of Brault either simultaneously with transfer or as a subsequent step following transfer motivated by the fact that Sandor, also drawn to method for the adhesive transfer of electrophotographic images from a transfer sheet to a target substrate (abstract), discloses that following transfer, the image can be overcoated with a layer of clear, durable seal coat resin, i.e., a varnish (column 7, lines 19-22., column 10, lines 40-50).

### ***Response to Arguments***

12. Applicant's arguments filed 30 May 2005 have been fully considered but they are not persuasive.

13. Applicant argues Brault does not disclose "the characteristics of an adhesive spreading over the pattern due to its surface tension." If applicant can show that this feature was supported by the original specification, the claim recites that "the surface tension of the adhesive allows it to spread" and the use of "allow" makes this unclear as to what exactly the applicant is trying to claim. Furthermore, it is the examiner's position that

Art Unit: 1734

adhesive in Brault spreads over the surface, thus it must have the surface tension to "allow" it spread within the meaning of the claim.

14. Applicant goes onto argue that the 3M adhesive in Brault is not transparent as required by claims 7 and 10. Included herein an information sheet found at the 3M™ Website to show that this adhesive is in fact clear or transparent.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

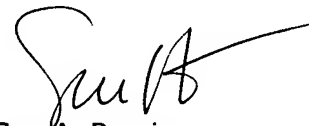
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis  
Primary Examiner  
Art Unit 1734

SP  
May 30, 2005